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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/327,713 | 06/08/1999 | KIMIHIKO NISHIOKA | PM260332 | 5810 |

909 7590 11/20/2002
PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

PARKER, KENNETH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2871

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/327,713

Applicant(s)

NISHIOKA, KIMIHIKO

Ch

Examiner

Kenneth A Parker

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 1-32, 34-36, 50-53, 67, 68 and 79-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33, 37-49, 54-66 and 69-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33, 27, 41, 43- 44, 49, 54, 57 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the devices disclosed, does not reasonably provide enablement for all of the optical devices which would use these elements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Listing simply pairs of common optical elements with no relationship cannot possibly enable all of the myriad of inventions which would use the elements.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 41-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural

cooperative relationships are: the relationship between the elements. Since no relationship at all is specified, the claims are indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 37-49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baba et al.

Baba et al discloses a system with a reflective variable lens with an oval section. Therefore, these claims are anticipated by Baba et al.

Claims 33, 37-49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sasaki et al 5020903

Sasaki et al 5020903 discloses a system with a reflective variable lens with an oval section. Therefore, these claims are anticipated by Sasaki et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olmstead et al 6073851.

Olmstead et al 6073851 adjustable lens, output detection, oblong shape (see figure 22) in a system with a lens which is not reflective. Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. The use of aspherical elements was well known for compensating for other distortions, and would have been obvious for that reason. The method limitations do not patentably distinguish the claims as they do not define a materially different invention. Please note that with product by process claims, the burden shifts back to applicant to show a patentable distinction. See MPEP 2111-2113.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al 5594549.

Mori et al adjustable lens, output detection, oblong shape in a system with a lens which is reflective. Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. The use of aspherical elements was well known for compensating for other distortions, and

would have been obvious for that reason. The method limitations do not patentably distinguish the claims as they do not define a materially different invention. Please note that with product by process claims, the burden shifts back to applicant to show a patentable distinction. See MPEP 2111-2113.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto 6191829.

Hashimoto et al adjustable lens, output detection, oblong shape in a system with a lens which is not reflective. Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. The use of aspherical elements was well known for compensating for other distortions, and would have been obvious for that reason. The method limitations do not patentably distinguish the claims as they do not define a materially different invention. Please note that with product by process claims, the burden shifts back to applicant to show a patentable distinction. See MPEP 2111-2113.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al 6025866.

Tsuchiya et al 6025866 discloses a system with a lens which is not reflective. Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. The use of aspherical elements was well known for compensating for other distortions, and would have been

obvious for that reason. The method limitations do not patentably distinguish the claims as the do not define a materially different invention. Please note that with product by process claims, the burdon shift back to applicant to show a patentable distinction. See MPEP 2111-2113.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba et al.

Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. . The use of asherical elements was well known for compensating for other distortions, and would have been obvious for that reason. The method limitations do not patentably distinguish the claims as the do not define a materially different invention. Please note that with product by process claims, the burdon shift back to applicant to show a patentable distinction. See MPEP 2111-2113.

Claims 33, 37-49, 54-66, 69, 70, 71, 72, 73-76, 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al 5020903.

Reflective variable focal length elements were well known functionally equivalent alternatives, and would have been obvious for that reason. . The use of asherical elements was well known for compensating for other distortions, and would have been obvious for that reason. The method limitations do not patentably distinguish the claims

as the do not define a materially different invention. Please note that with product by process claims, the burdon shift back to applicant to show a patentable distinction. See MPEP 2111-2113.

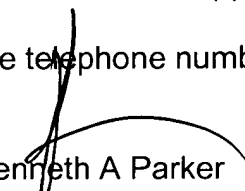
Election/Restrictions

Applicant's election is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Parker whose telephone number is 703-305-6202. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L. Sikes can be reached on 308-4842. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0956.


Kenneth A Parker
Primary Examiner
Art Unit 2871

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Art Unit: 2871

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November 17, 2002